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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,596	11/02/2004	Reinhard Treiber	260777US0PCT	5698

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT PAPER NUMBER

1714

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,596

Applicant(s)

TREIBER ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/05</u> . | 6) <input type="checkbox"/> Other: ____. |

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 6-11, and 13-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4147679 Scriven et al..

Scriven discloses the instantly claimed aqueous polyurethanes, coating methods, and coated substrates at the abstract; column 3, lines 24-55 and 58-68; column 4, lines 1-68, particularly 25-68; column 5, lines 1-68, particularly 1-4 and 67-68; column 6, lines 1-68, particularly 12-32 which encompasses the instantly claimed isocyanates and amounts thereof of the instant claims 1-3; column 7, lines 1-68; column 8, lines 1-68, particularly 10-68 which encompasses the instantly claimed components c through e; column 9, lines 1-68; column 10, lines 1-68; column 11, lines 1-68, particularly 1-7; column 12, lines 1-68; column 13, lines 1-68; column 14, lines 1-68, particularly 38-43 which falls within the scope of the instant claim 11; column 15, lines 1-68, particularly 21-68 which encompasses the instantly claimed amounts of components c and d; column 16, lines 1-68, particularly 1-11, 26-37, which encompasses the instantly claimed amounts of component e, and 49-68; column 17, lines 1-68, particularly 23-55; column 18, lines 1-68, particularly 3-15, which encompasses the instantly claimed particle sizes and 45-68;

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column 19, lines 1-68, particularly 19-68 which falls within the scope of the instantly claimed components f and g; column 20, lines 1-68, particularly 14-28; column 23, lines 25-36 which encompasses the instantly claimed coating methods and coated substrates; column 24, lines 35-68 which encompasses the instantly claimed reactant amounts as does column 25, lines 1-68; column 26, lines 1-68 and the remaining examples; and the remainder of the document. Column 30, line 32-33 falls within the scope of the instant claim 10.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4147679 Scriven et al..

Scriven discloses the instantly claimed aqueous polyurethanes, coating methods, and coated substrates at the abstract; column 3, lines 24-55 and 58-68; column 4, lines 1-68, particularly 25-68; column 5, lines 1-68, particularly 1-4 and 67-68; column 6, lines 1-68, particularly 12-32 which encompasses the instantly claimed isocyanates and amounts thereof of the instant claims 1-3; column 7, lines 1-68; column 8, lines 1-68, particularly 10-68 which encompasses the instantly claimed components c through e; column 9, lines 1-68; column 10, lines 1-68; column 11, lines 1-68, particularly 1-7; column 12, lines 1-68; column 13, lines 1-68; column 14, lines 1-68, particularly 38-43 which falls within the scope of the instant claim 11; column 15, lines 1-68, particularly 21-68 which encompasses the instantly claimed amounts of components c and d; column 16, lines 1-68, particularly 1-11, 26-37, which encompasses the instantly claimed amounts of component e, and 49-68; column 17, lines 1-68, particularly 23-55; column 18, lines 1-68, particularly 3-15, which encompasses the instantly claimed particle sizes and 45-68; column 19, lines 1-68, particularly 19-68 which falls within the scope of the instantly claimed components f and g; column 20, lines 1-68, particularly 14-28; column 23, lines 25-36 which

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encompasses the instantly claimed coating methods and coated substrates; column 24, lines 35-68 which encompasses the instantly claimed reactant amounts as does column 25, lines 1-68; column 26, lines 1-68 and the remaining examples; and the remainder of the document. Column 30, line 32-33 falls within the scope of the instant claim 10.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed ingredient combinations and amounts thereof because they are encompassed by the patentee and would have been expected to give coatings having the properties described by the patentee.

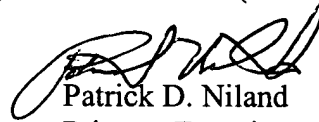
It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed cesium salt of claim 12 because Scriven discloses the use of catalysts generally and cesium salts are well known to catalyze the urethane reaction as shown by Endo, abstract; column 3, lines 3-6 and the remainder of the document and Murphy, column 1, lines 55-72; column 2, lines 60-72; column 4, lines 46-47 and 59.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed amine of claim 8 because cyclic amines are encompassed as the chain extenders of Scriven and isophorone diamine is a well known urethane chain extender as taught by Scriven (729) column 6, lines 61-68; column 7, lines 1-6 of which isophorone diamine is that of the instant claim 8, which would give its known properties to the final urethane of Scriven (679).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick D. Niland
Primary Examiner
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